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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,578	01/08/2002	Jacques Durocher	85493-423	1432
28291	7590	05/13/2004	EXAMINER	
SMART & BIGGAR/FETHERSTONHAUGH 1000 de la GAUCHETIERE WEST SUITE 3400 MONTREAL, QC H3B 4W5 CANADA			KLEBE, GERALD B	
			ART UNIT	PAPER NUMBER
			3618	

DATE MAILED: 05/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/038,578	<b>Applicant(s)</b> DUROCHER, JACQUES	
	<b>Examiner</b> Gerald B. Klebe	<b>Art Unit</b> 3618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 7-9 and 15-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 1-14, and 21-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

*G.B. Klebe*  
5 May 2004

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Amendment***

1. The amendment filed 3/04/2004 under 37 CFR 1.111 has been entered. New claims 21-31 having been added by the amendment, claims 1-31 are pending in the application. Claims 1, 10, and 24 are independent, and claims 7-9 and 15-20 are withdrawn from consideration.

### ***Claims Rejections - 35 U.S.C. § 112, 2<sup>nd</sup> Para.***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2, 6, and 21-22, 10-14 and 23, and 25-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 2, claim 10 and claim 25 each recite the limitation "fork-like" which renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by " - like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Appropriate correction is required.

### ***Claims Rejections - 35 U.S.C. 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Lenoir (US 6557864).

Lenoir discloses an in-line roller skate comprising: (a) a boot having an upper comprising a bottom portion; (b) a chassis carrying a plurality of aligned wheels, the chassis being mounted to the boot; and (c) an outsole covering the bottom portion of the upper and comprising a heel portion having a cavity and a resilient component inserted within (re: claim 1), and entirely confined within (re: claim 24), the cavity.

***Claims Rejections - 35 U.S.C. § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-6, 21-22, and 25-31, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Lenoir (US 6557864) in view of Goodwin et al. (US 6119371).

As discussed above, Lenoir discloses all of the features of claim 1 and claim 24.

a. Lenoir lacks explicit disclosure of a boot outer sole wherein the heel portion comprises a structure having upper and lower platforms defining a cavity within which the resilient component is inserted, the upper and lower platforms being adapted to flex at their intersecting portion compressing the resilient component.

b. However, Goodwin et al. teaches (refer Fig 3) (**re: claims 2, 3, 25, and 26**) a sports boot wherein the heel portion has a structure having upper and lower platforms defining a cavity within which the resilient component (20), and (**re: claims 4 and 27**) made of an elastomeric material (col 6, lines 34-37) comprising (**re: claims 5 and 28**) at least one air pocket (refer col 5, lines 5-16), is inserted wherein the upper platform and lower platform branch out from an intersecting portion of the fork-like structure and are able to flex at the intersecting portion for compressing the resilient component when one of the aligned wheels abuts an obstacle.

c. It would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have substituted the boot of Goodwin et al. for the boot of Lenoir in order to have a more resilient and longer lasting heel cushioning element as suggested by the reference at column 1, lines 21-47.

d. (**re: claims 6 and 29, 21 and 30, and 22 and 31**) Lenoir further discloses (**re: claims 6 and 29**) a rear mounting bracket (44) extending downwardly from the lower platform, the mounting bracket comprising apertures for mounting the boot to a rear portion of the chassis (refer col 3, lines 62-64); and further comprising (**re: claims 21 and 30**) a front mounting bracket (refer Fig 8, item 19) extending downwardly from a front portion of the outsole and wherein (**re: claims 22 and 31**) a midsole (Fig 5, item 36) is enclosed between the bottom portion of the upper and the front portion of the outsole.

**Regarding the further feature of claim 6 and claim 29 wherein the mounting apertures are co-axial**, it would have been an obvious matter of design choice to have mounted the bracket by any convenient means including by use of co-axial apertures, since applicant has

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not disclosed that the co-axial aspect of the mounting apertures solves any state problem or is for any particular purpose and it appears that the invention would perform equally well with the screw and nut means disclosed by Lenoir (refer col 3, lines 62-64).

9. Claims 10-14, and 23, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Lenoir (US 6557864) in view of Goodwin et al. (US 6119371).

a. Lenoir discloses an in-line roller skate comprising: **(re: claim 10)** (a) a boot comprising an upper and the upper comprising a bottom portion; (b) a chassis mounted to the boot and carrying a plurality of aligned wheels; and (c) an outsole covering the bottom portion of the upper, the outsole comprising a heel portion having a space for receiving a resilient component; and **(re: claim 11)** wherein the resilient component (20) is made of elastomeric material (refer Goodwin et al. col 6, lines 34-37); and **(re: claim 12)** wherein the resilient component comprises at least one air pocket (refer col 5, lines 5-16); and **(re: claim 13)** further comprising a rear mounting bracket (refer Lenoir, Fig 5, item 44; refer col 3, lines 63-65) extending downwardly from the lower platform for mounting a rear portion of the chassis to the skate boot; and further comprising **(re: claim 14)** a front mounting bracket extending downwardly from a front portion of the outsole (refer Fig 8, item 19); and wherein **(re: claim 23)** a midsole (Fig 5, item 36) is enclosed between the bottom portion of the upper and the front portion of the outsole.

b. **Regarding the further feature of claim 10**, Goodwin et al. further teaches a sports footwear boot having an upper and a bottom portion wherein an outsole covering the bottom portion of the upper further comprises (refer Fig 3) a heel portion comprising a structure having upper and lower platforms defining a space there-between, these upper and lower

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platforms branching out from an intersecting portion of the structure and adapted to flex at the intersection portion.

c. It would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have substituted the footwear boot of Goodwin et al. for the boot of Lenoir in order to provide a more cushioned heel to make the skate better equipped for the heel impact shocks encountered in stunt skating.

***Response to Argument***

10. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Action made Final; New Grounds necessitated by Amendment***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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***Conclusion***

12. Any inquiry concerning this or earlier communication(s) from the examiner should be directed to Gerald B. Klebe at 703-305-0578, fax 703-872-9306; Mon.-Fri., 8:00 AM - 4:30 PM ET, or to Supervisory Patent Examiner Brian L. Johnson, Art Unit 3618, at 703-308-0885.

Note that the examiner's fax number has changed.

Official correspondence should be sent to the following TC 3600 Official Rightfax numbers as follows: Regular correspondence: 703-872-9326; After Finals: 703-872-9327; Customer Service: 703-872-9325.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*gbklebe*  
gbklebe / Art Unit 3618 / 10 May 2004

*Bryan Fischmann* 5-10-4  
**BRYAN FISCHMANN**  
**PRIMARY EXAMINER**